## REMARKS

### I. Status of the Claims

Claims 1-6 and 8-55 are pending in this application. The above amendments of claims 8, 9, 18, and 20 correct the claim dependency of those claims in light of the previous amendment canceling claim 7 and incorporating the recited limitations of claim 7 into claim 1. Support for the above amendments are found in the original specification. For example, the amendments are supported by original claims 7, 8, 9, 18, and 20. No new matter has been added.

### II. Rejection under 35 U.S.C. § 103(a)

#### *Rondeau*

Claims 1-6 and 8--55 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,001,135 to Rondeau ("Rondeau") for the reasons of record, e.g., as set forth in the Office Action dated September 13, 2000. Applicant traverses this rejection for reasons of record, and as supplemented below.

To establish a *prima facie* case of obviousness, an Examiner must meet three basic criteria. First, he or she must demonstrate that there is some suggestion or motivation, either in the cited references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or combine reference teachings. Second, an Examiner must demonstrate that there was a reasonable expectation of success. Finally, the prior art reference(s) must also teach or suggest all the claim limitations. *See* M.P.E.P. § 2143. Furthermore, the teaching or suggestion to

make the claimed combination must be found in the prior art, not in Applicants' disclosure. *See* In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

In the present case, the Office has failed to make a *prima facie* case of obviousness because at least the first two of the above criteria have not been met.

The Office asserts that

> [I]t would have been obvious to those skilled in the art to substitute the sawdust excipient in Rondeau's Example 2 with a polymer as claimed, e.g. a cellulose or gum derivative, because the patentee teaches the equivalence between such excipients for use in the patentee's compositions. The Office holds the position that the various claimed processes and kits are obvious variants of Rondeau's processes and kits because the same end-results would be expected and obtained, i.e. the application of a cationic dye, oxidation base, polymer, and oxidant to the hair, absent a showing otherwise.

Office Action dated September 13, 2000, page 7, emphasis added. Applicant herein submits arguments and comparative experimental data indicating that Rondeau's composition with sawdust is not equivalent to the instant claimed composition comprising at least one thickening polymer.

Applicant traverses this rejection by first pointing out that "organic pulverulent excipients" are not art-recognized equivalents of "thickening polymers".

In order to rely on equivalence as a rationale supporting an obviousness rejection, the equivalency must be recognized in the prior art, and cannot be based on Applicants' disclosure or the mere fact that the components at issue are functional or mechanical equivalents. *See* In re Ruff, 356 F.2d 590, 118 U.S.P.Q. 340 (CCPA 1958) *Rondeau.*'s organic pulverulent excipient is just that, *i.e.*, "an inert substance used as a

diluent or vehicle" (excipient[1]) "made of, covered with, or crumbling to fine powder or dust" (pulverulent[2]). The present invention concerns novel compositions for dyeing keratin fibers which are capable of giving more intense and yet unselective colorations which show good resistance to the various attacking factors to which the hair may be subjected, by combining at least one thickening polymer comprising at least one sugar with at least one known cationic direct dye. (Specification, page 2, line 19, through page 3, line 5.) *Rondeau* does not disclose using a thickening polymer for giving more intense and yet unselective colorations which show good resistance to the various attacking factors to which the hair may be subjected. Accordingly, there is no reason why one of ordinary skill in the art would conclude that the excipients taught by *Rondeau* at column 23, lines 24-31, are equivalent to the thickening polymers taught and claimed in the present application.

Further, the Applicant has conducted and presents herewith a declaration under 37 C.F.R. § 1.132 providing a comparative study of *Rondeau's* composition compared to Applicant's claimed composition. Comparative testing was performed with inventive Composition A and comparative Compositions B and C. Composition A was prepared according to the present invention, containing at least one cationic direct dye and at least one thickening polymer comprising at least one sugar as recited in the claims. Composition B was prepared without the at least one thickening polymer of Composition A. Composition C was prepared with sawdust used in the place of the at least one thickening polymer of Composition A.

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[1] *The American Heritage College Dictionary (Third Edition)*, Houghton Mifflin Company, Boston, 2000.

The results show that a thick composition (558 centipoise) is obtained with the composition according to the invention (Composition A), whereas liquid fluids (1 centipoise) are obtained in the comparative compositions. The addition of sawdust apparently has no significant consequence on the viscosity, and results in a viscosity of 1 centipoise, which corresponds to the viscosity of water. One of ordinary skill in the art would understand that a composition having the viscosity of water is not convenient for application to hair. Thus, replacing the at least one thickening polymer with sawdust in Composition C does not result in a composition having a viscosity convenient for application to hair. Accordingly, one of skill in the art would not be motivated to add sawdust to the hair composition of the present invention in place of the thickening polymer; such a modification clearly does not enhance the viscosity of the resulting composition.

Further, this declaration under 37 C.F.R. § 1.132 provides the "clear and particular evidence", required by Federal Circuit case law, that one of ordinary skill in the art at the time of filing would not have concluded that the sawdust excipient taught by *Rondeau* would be equivalent to the thickening polymers claimed in the present application. Accordingly, one of ordinary skill in the art would not have been motivated to modify Rondeau to obtain the claimed invention as suggested by the Office.

In addition, even if one did make the substitution suggested by the Office, this declaration under 37 C.F.R. § 1.132 clearly indicates that there would have been no reasonable expectation of success. The declaration under 37 C.F.R. § 1.132 shows that sawdust is not useful as a thickening polymer as claimed in the present application.

Accordingly, one of ordinary skill in the art would not have expected success from substitution of a sawdust excipient for the thickening polymer of the instant claims.

Therefore, in view of the arguments of record and the declaration under 37 C.F.R. § 1.132 showing that sawdust is not useful as a thickening polymer in the presently claimed compositions, one of ordinary skill in the art would not have been motivated to modify *Rondeau* to obtain the present inventive compositions, nor would there have been a reasonable expectation of success in doing so. Accordingly, Applicant respectfully requests that the rejection be withdrawn.

**French Patent No. 2,757,388 to Rondeau**

Claims 1-6 and 8--55 have also been rejected under 35 U.S.C. § 103(a) as being unpatentable over French Patent No. 2,757,388 to Rondeau, as the Office alleges this French patent is equivalent to U.S. Patent No. 6,001,135 ("Rondeau") for the same reasons as applied in the above rejection. Office Action, page 5. Applicant traverses this rejection for the same reasons argued above. Applicant incorporates herein by reference the remarks to the above rejection, and applies them to the instant rejection.

In view of the above arguments and the declaration under 37 C.F.R. § 1.132 showing that sawdust is not useful as a thickening polymer in the presently claimed compositions, one of ordinary skill in the art would not have been motivated to modify French Patent No. 2,757,388 to Rondeau to obtain the present inventive compositions, nor would there have been a reasonable expectation of success in doing so. Accordingly, Applicant respectfully requests that the rejection be withdrawn.

## III. Rejection under 35 U.S.C. § 112, second paragraph

Claims 8, 9, 18, and 20 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite because they remain dependent on claim 7, which has been canceled. Applicant has amended the claims to correct the claim dependencies. Applicant respectfully requests reconsideration and withdrawal of the rejection.

## IV. Conclusion

In view of the foregoing remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this Amendment and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

**FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, L.L.P.**

By: 

Charles D. Niebylski
Reg. No. 46,116

Dated: August 12, 2004

PATENT
Customer No. 22,852
Attorney Docket No. 05725.0441

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

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| In re Application of: | ) | |
| | ) | |
| Christine RONDEAU | ) | |
| | ) | |
| Application No.: 09/349,105 | ) | Group Art Unit: 1751 |
| | ) | |
| Filed: July 8, 1999 | ) | Office: M. Einsmann |
| | ) | |
| For: COMPOSITION FOR DYEING KERATIN FIBERS WITH A CATIONIC DIRECT DYE AND A THICKENING POLYMER | ) | |

**Mail Stop - RCE**
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

**DECLARATION UNDER 37 C.F.R. § 1.132**

I, Jean COTTERET, declare and state that:

1. I am a French citizen, residing at 13 rue du Pré Rousselin, 78480 Verneuil sur Seine, France.

2. I have been awarded a degree in Chemical Engineering from l'Ecole National Supérieure de Chimie de Paris .

3. I have been employed by L'ORÉAL since October 1976, and I am presently employed as Assistant of the Director of the R & D Centre for Hair Products at L'ORÉAL. During my employment at L'ORÉAL, I have been engaged in the research and development of hair products.

4. Given my education and experience, particularly in the area of hair care, I consider myself able to provide the following testimony based on experiments conducted under my direct supervision.

## COMPARATIVE TESTING

Comparative testing was performed with inventive Composition A and comparative Compositions B and C. Composition A was prepared according to the present invention, containing at least one cationic direct dye and at least one thickening polymer as claimed. Composition B was prepared without the at least one thickening polymer of Composition A. Composition C was prepared with sawdust used in the place of the at least one thickening polymer of Composition A.

### I. COMPOSITIONS

The test compositions are summarized in the following table and described in detail below:

| Compounds | Composition A (invention) | Composition B (comparative) | Composition C (comparative) |
|---|---|---|---|
| Basic Red 51 | 0.2 | 0.2 | 0.2 |
| Hydroxyethylcellulose | 1 | - | - |
| Sawdust | - | - | 1 |
| Ethanol | 10 | 10 | 10 |
| 2-amino 2-methyl 1-propanol | QS' pH=9 | | |
| Water QSP | 100 | | |

## II. VISCOSITY MEASUREMENT

The viscosity of each composition was measured on a viscosimeter Rheomat 180, 25°C, 200 rd/mns, with module 1 or 2 according to the viscosity.

## III. RESULTS

| | Composition A (invention) | Composition B (comparative) | Composition C (comparative) |
|---|---|---|---|
| Viscosity (centipoise) | 558 | 1 | 1 |

These results show that a thick composition is obtained with the composition according to the invention, whereas liquid fluids are obtained in the other cases. The addition of sawdust has no significant consequence on the viscosity.

A viscosity of 1 centipoise corresponds to the viscosity of water. Therefore, Compsoition B and Composition C are not of a convenient viscosity for an application of either composition on hair. Accordingly, addition of sawdust in Composition C does not result in a composition having a viscosity convenient for an application on hair.

I further declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further, that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Dated: July 30, 2004. By: Jean COTTERET
Jean Cotteret